

Applicant's amendments and comments, received February 13, 2008, have been fully considered by the examiner. The following is a complete response to the February 13, 2008 communication.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7, 8, 10, 11, 13-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharps et al (6,602,248) in view of the teaching of Banko (3,659,607).

Sharps et al disclose a device and method for treating an intervertebral disc. Access to the disc is gained by advancing a needle device (928 – Figures 41 and 44) into the disc. Sharps et al disclose treatment of the disc using a treatment device (918) that is inserted into the disc and provides RF energy to treat the disc tissue. The device may include a both poles of the RF electrode system on the treatment device, or only one pole on the device with the return pole located elsewhere within the disc (col. 56, lines 55-67). Sharps et al also disclose providing fluid to the disc space (col. 56, lines 1-15), as well as the use of various imaging techniques to view the disc space prior to and during treatment. Among the imaging techniques is the insertion of a fiber optic into the disc space through ancillary probe member (938). There is no specific teaching that a single access device is used to provide insertion of the optical fiber to view the tissue,

followed by removal of the optical fiber and insertion of the treatment tool to treat tissue as recited in the instant claims.

The examiner maintains that the use of a single access device, which would minimize the trauma to the disc tissue, to perform both viewing and treating functions would be an obvious alternative methodology for one of ordinary skill in the art. In particular, Banko teaches that it is known to use a single access device, in this case for accessing ocular tissue, through which a variety of imaging and treatment devices may be individually advanced to perform a given procedure (col. 1, lines 45-60).

The specific steps of intermittently viewing and then treating tissue is deemed to be an obvious methodology for accurately and successfully performing the procedure. That is, one of ordinary skill in the art would obviously recognize the advantages of intermittently viewing the treatment area to assure the proper tissue is being treated and to ensure the treatment has been successfully performed.

The use of a single access device for selectively imaging and treating disc tissue while minimizing the trauma to the disc in the Sharps et al system would have been an obvious alternative methodology for one of ordinary skill in the art, particularly since Banko teaches that it is generally known to use a single access device for selectively inserting various imaging and treatment devices.

Response to Arguments

Applicant's arguments filed February 13, 2008 have been fully considered but they are not persuasive.

Applicant initially notes that neither Sharps nor Banko disclose a step of independently advancing an optic fiber through an access device comprising a needle and into a disc. However, as addressed above, Sharps does disclose a method of advancing a needle into a disc and treating the disc with an activation device as is generally known in the art. Sharps also discloses visualizing the procedure with a separately inserted fiber optic (Figures 41 and 44). Thus, the examiner has provided the Banko reference which clearly discloses that it is known to use a single access device through which an optical fiber may be advanced before and after the operation. Other devices are also provided through the same access device (upon removal of the optical fiber) for treating the tissue. Hence, Banko clearly teach that it is a known procedure to provide a single access device and to provide an optical fiber to view an interior of the tissue space prior to treatment. This method removes the requirement of using two separate access devices thereby providing less trauma to small tissue areas. The examiner maintains that one of ordinary skill in the art would clearly be motivated to operate the Sharps device in the same manner to avoid using the extra viewing access device inserted into the narrow disc space. With regard to applicant's assertion that the Banko needle is not an access device, the examiner maintains that such a characterization is immaterial to the rejection at hand. Sharps discloses the needle access device for accessing the interior of a disc. Banko is merely cited as a teaching that it is known to use a single access device to alternately advance a treatment device and a viewing device such that only one access device is needed. As such, Sharps discloses the specific access device (i.e. needle) and Banko provides the proper

motivation for the skilled artisan to use that single needle access device for alternately advancing the treatment device and the viewing device as necessary to perform the procedure. Banko further specifically states the viewing optics may be provided prior to treatment (col. 1, lines 45-60), which treatment protocol would clearly motivate one of ordinary skill in the art to consider such a methodology in the Sharps method. Applicant has not separately argued the dependent claims, and the examiner maintains the rejection of these claims remains tenable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/
Primary Examiner, Art Unit 3739